

### REMARKS

The Office Action mailed September 21, 2010 has been reviewed and carefully considered. No new matter has been added.

Claims 1 and 8 have been amended. Claims 1-9 are pending.

Initially, the Applicants gratefully acknowledge the Examiner's indication that the Information Disclosure Statements of August 14, 2008 and December 12, 2005 have been fully considered by the Examiner.

Moreover, we note that the instant application is related in disclosed subject matter to U.S. Patent Application Ser. No. 10/559,242 (hereinafter the "'242 Application"). In that regard, we further note that the instant application is primarily directed to decoder/decoding claims, while the '242 Application is primarily directed to encoder/encoding claims.

By the pending Office Action, Claims 1-9 stand rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Application No. EP 0 883 299 A2 to Nakagawa et al. (hereinafter "Nakagawa").

The independent claims in the instant application are Claims 1 and 8.

It is respectfully asserted that Nakagawa does not teach or suggest the following limitations of Claim 1 (emphasis added):

1. A spatial scalable video decoder for receiving each of a standard-resolution bitstream and a high-resolution scalable bitstream and providing a high-resolution video sequence, the decoder comprising:
  - an I-picture detector for receiving the standard-resolution bitstream;
  - a non-scalable standard-resolution Intra decoder in signal communication with the I-picture detector for non-scalably decoding standard-resolution I-pictures to provide decoded standard-resolution I-pictures;
  - a high-resolution video decoder for receiving the high-resolution scalable bitstream; and
  - a selector in signal communication with the standard-resolution Intra video decoder and the high-resolution video decoder for selecting between the

outputs from the standard-resolution Intra video decoder and the high-resolution video decoder to provide the high-resolution video sequence.

Moreover, it is respectfully asserted that Nakagawa does not teach or suggest the following limitations of Claim 8 (emphasis added):

8. (Currently Amended) A decoding method for providing spatial scalable decoded video data, the method comprising:  
receiving a standard-resolution bitstream;  
receiving a high-resolution scalable bitstream;  
non-scalably Intra decoding standard-resolution I-pictures from the standard-resolution bitstream to provide decoded standard-resolution I-pictures;  
up-sampling the decoded I-picture to high-resolution;  
high-resolution decoding a current picture from the high-resolution scalable bitstream; and  
summing the decoded current picture with the up-sampled I-picture.

Initially, we note that Claim 1 explicitly recites and is thus directed to a “video decoder”. Moreover, Claim 8 explicitly recites and is thus directed to a “decoding method”.

In contrast, all of the portions cited against Claims 1 and 8 from Nakagawa relate to ENCODER figure 1 of Nakagawa. However, as is known to those of ordinary skill in the art, an encoder is not a decoder. For example, even if an encoder has a decoder for reconstruction purposes, such decoder output is not an external output available as would be the case for an actual dedicated decoder. Thus, even if an encoder includes a decoder for reconstruction purposes, without being able to provide a decoded output, such an encoder can never be a decoder as is known and understood to those of ordinary skill in the art. In that regard, we note that the only output of the encoder of Figure 1 of Nakagawa is from codeword assignment unit 10, which generates “a coded video bitstream” (Nakagawa, col. 6, lines 41-44). Hence, at the onset, the Examiner has not

shown all of the limitations of the claims in the cited reference and has thus failed to set forth a prima facie case of rejection.

Moreover, each of Claims 1 and 8 essentially recite non-scalably Intra decoding standard-resolution I-pictures from the standard-resolution bitstream to provide decoded standard-resolution I-pictures. In contrast, the cited portion of Nakagawa, namely col. 5, lines 22-27, disclose the following:

a first updating unit to convert the low-resolution picture retrieved from the low-resolution picture storage unit 4 to obtain high-resolution block images corresponding only to coded blocks with non-zero motion vectors and intra-coded (i.e., intra-frame coded) blocks, while the low resolution mode is effective, and store the high-resolution block images to the high-resolution picture storage unit 3....

Thus, one difference between the above reproduced limitations of Claims 1 and 9 and the cited portion of Nakagawa is, as noted above, that the former pertains to a video decoder while the latter pertains to a video encoder. We note that the same is not a trivial difference as an encoder (including the encoder shown in Figure 1 of Nakagawa) does not provide a decoded external output.

Another difference between the above reproduced limitations of Claims 1 and 9 and the cited portion of Nakagawa is that while the reproduced limitations explicitly involve non-scalably decoding (i.e., from a standard-resolution to a standard-resolution), the cited portion involve what amounts to scalably converting (i.e., from a low-resolution to a high-resolution). Thus, in this regard, the cited portion of Nakagawa actually teaches away from the explicit limitations recited in Claims 1 and 8. However, as set forth in MPEP 2145.X.D.1: It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference

expressly excluding antimony from, and adding iron to, a catalyst.).

Moreover, converting as disclosed by Nakagawa is not the same as decoding as recited in Claims 1 and 8, as decoding requires being previously encoded while converting does not. In fact, a conversion would seem to require the same states regarding pre-conversion and post-conversion, namely an uncompressed picture.

Yet another difference between the above reproduced limitations of Claims 1 and 8 and the cited portion of Nakagawa is that the outputs of the “non-scalable standard-resolution Intra decoder” recited in Claim 1 and the step of non scalably Intra decoding recited in Claim 8 is “decoded standard-resolution I-pictures”, while the output of the first updating unit cited by the Examiner is high-resolution images (and the only output of the encoder of Figure 1 of Nakagawa is a coded video bitstream as noted above).

We will now address decoder Figure 2 of Nakagawa. The same completely fails to teach or suggest, *inter alia*, non-scalably Intra decoding standard-resolution I-pictures from the standard-resolution bitstream to provide decoded standard-resolution I-pictures as essentially recited in Claims 1 and 8. For example, we initially note that while the recited limitations of Claims 1 and 8 provide a low complexity approach to decoding, with such low complexity pertaining to, *inter alia*, a fixed resolution (input a compressed (encoded) standard-resolution picture and output an uncompressed (decoded) standard-resolution picture and the limiting of decoded pictures to intra pictures which are clearly less complex to decode than inter-coded pictures such as P or B-pictures, as is readily known and understood to one of ordinary skill in the art.

In contrast, the decoded picture generator 28 in Figure 2 of Nakagawa outputs both low-resolution and high-resolution pictures (see, e.g., Nakagawa, col. 19, lines 22-25). Moreover, the decoded picture generator 28 in Figure 2 of Nakagawa outputs both intra coded and inter coded pictures (see, e.g., Nakagawa, col. 19, lines 50-53, and col. 20, lines 4-5). Thus, un-cited decoder Figure 2 of Nakagawa also fails to teach or suggest the above reproduced limitations of Claims 1 and 8.

Thus, in all these regards, Nakagawa fails to teach or suggest all the above reproduced limitations of Claims 1 and 8.

Accordingly, Nakagawa does not teach or suggest the above-recited elements of

Claims 1 and 8.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Since all of the recited claim elements are not taught or suggested by Nakagawa, a proper prima facie anticipation rejection has not been constructed. Accordingly, Claims 1 and 8 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above, and the rejection must be withdrawn.

Claims 2-7 directly or indirectly depend from Claim 1 and, thus, include all the elements of Claim 1. Claim 9 directly depends from Claim 8 and, thus, includes all the elements of Claim 8. Accordingly, Claims 2-7 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to Claim 1, and Claim 9 is patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to Claim 8.

Thus, reconsideration of the rejection is respectfully requested.

In view of the foregoing, Applicants respectfully request that the rejection of the claims set forth in the Office Action of September 21, 2010 be withdrawn, that pending claims 1-9 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

No fee is believed due with regard to the filing of this amendment. However, if a fee is due, please charge Deposit Account No. 07-0832.

Respectfully submitted,

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